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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,995	07/24/2003	Joshua D. Coombs	10541-1721	4167

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EXAMINER

TO, TOAN C

ART UNIT	PAPER NUMBER
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3616

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,995

Applicant(s)

COOMBS ET AL.

Examiner

Toan C. To

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13 is/are rejected.
- 7) ☒ Claim(s) 9-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/24/03; 10/16/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, are drawn to a suspension system, classified in class 280, subclass 124.157.
 - II. Claims 14-19, are drawn to a volume modulator, classified in class 91, subclass 180.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the modulator of the invention II has utility in other combination. The subcombination as to the modulator has separate utility such as it can be used with a continuously variable transmission system.

During a telephone conversation with Mr. Sosenko, Eric on July 28, 2005 a provisional election was made with traverse to prosecute the invention I, claim 1-13. Affirmation of this election must be made by applicant in replying to this Office action.

3. Claims 14-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) and 37 CFR 1.83(a) because reference characters "18" and "58" have both been used to designate a single element in figure 2, and they fail to show a motor 66 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,811,167.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-7 of U.S. Patent No. 6,811,167 respectively read on claims 1-7 of the instant application.

7. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,814,364.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the following reasons:

Claims 1 and 2 of U.S. Patent No. 6,814,364 read on claim 1 of the instant application.

Claim 6 of U.S. Patent No. 6,814,364 read on claim 2 of the instant application.

Claim 7 of U.S. Patent No. 6,814,364 read on claim 3 of the instant application.

Claim 8 of U.S. Patent No. 6,814,364 read on claim 4 of the instant application.

Claim 3 of U.S. Patent No. 6,814,364 read on claim 5 of the instant application.

Claim 4 of U.S. Patent No. 6,814,364 read on claim 6 of the instant application.

Claim 5 of U.S. Patent No. 6,814,364 read on claim 7 of the instant application.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 8, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakai (U.S. 5,486,018).

Sakai discloses a suspension system for a vehicle having a wheel contacting a surface under the vehicle and a suspension link suspending the wheel from the vehicle and allowing relative movement of the wheel and the vehicle, said suspension system comprising: a compressible fluid; a suspension strut (102) adapted to couple the suspension link and the vehicle; a hydraulic cavity (106) at least partially defined by said suspension strut and adapted to contain a portion of said compressible fluid and to cooperate with said compressible fluid to supply a suspending spring force that biases the wheel toward the surface; a reservoir (592) adapted to contain a portion of said compressible fluid; and a volume modulator (551) coupled to said hydraulic cavity and said reservoir and adapted to selectively push said compressible fluid into said hydraulic

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cavity and vent said compressible fluid from said hydraulic cavity (106), thereby actively modulating said suspending spring force, wherein said volume modulator (551) defines a modulator cavity (561) and includes a modulator piston (557) adapted to cycle through a compression stroke and an expansion stroke within said modulator cavity (561), and includes a valve system (see columns 18-23) adapted to selectively restrict the passage of said compressible fluid between said hydraulic cavity (106) and said modulator cavity (561) or restrict the passage of said compressible fluid between said reservoir and said modulator cavity.

As to claim 2, Sakai discloses a suspension system, wherein said suspension strut (102) includes a displacement rod (112) adapted to move into said hydraulic cavity (106) and to compress said compressible fluid upon the relative movement of the wheel and the vehicle.

As to claim 3, Sakai discloses a suspension system, wherein said displacement rod includes a cavity piston (106) adapted to supply a damping force.

As to claim 4, Sakai discloses a suspension system, wherein said hydraulic cavity is defined by said suspension strut (106) and a hydraulic line adapted to communicate said compressible fluid between said suspension strut and said volume modulator (551).

As to claim 8, Sakai discloses a suspension system, wherein said valve system includes a rotary valve (703) coupled between said modulator cavity (561), said hydraulic cavity (106), and said reservoir (592).

As to claim 13, Sakai discloses a suspension system further comprising a hydraulic cavity valve (587) coupled along said hydraulic cavity () between said volume modulator (551) and said suspension strut (102) and adapted to selectively restrict the passage of said compressible fluid through said hydraulic cavity (106) and to selectively allow the passage of said compressible fluid through said hydraulic cavity.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai in view of Higginbotham (U.S. 3,653,676).

Sakai discloses every element of the invention as discussed above except that said compressible fluid includes a silicone fluid, and wherein said compressible fluid is adapted to compress about 1.5% volume at 2,000 psi, about 3% volume at 5,000 psi, and about 6% volume at 10,000 psi.

Higginbotham teaches the invention wherein the compressible fluid includes a silicone fluid (see column 4, line 69). With respect to claims 6-7, it is inherent that silicon fluid of Higginbotham would have the same compression characteristic as claimed in claims 6-7. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the suspension system of Sakai to alternatively use

silicon as a compressible fluid as taught by Higginbotham in order to sufficiently improve damping characteristic of the vehicle suspension.

Allowable Subject Matter

12. Claims 9-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan C. To whose telephone number is (571) 272-6677. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on (571) 272-6669. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTTo
August 6, 2005


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